

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte OLIVER BECK, MICHAEL FORSTER,  
CHRISTIAN GROMMER and NORBERT WOCHT

Appeal No. 2004-1325  
Application No. 09/121,702

HEARD: August 19, 2004

Before COHEN, STAAB, and McQUADE, Administrative Patent Judges.  
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1, 4-7, 9 and 11-14. Claims 15-17, the only other claims currently pending in the application, have been withdrawn from consideration as not being readable on the elected species.

Appellants' invention pertains to a four zone heating and air-conditioning system for a motor vehicle. Independent claims 1 and

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12, copies of which are found on pages 24-26 of appellants' corrected main brief (Paper No. 31), are representative of the subject matter in issue.

The following references have been relied upon by the examiner as evidence of obviousness:<sup>1</sup>

Otsuka et al. (Otsuka)	3,881,546	May 06, 1975
Logsdon	3,967,779	Jul. 06, 1976
Moore	4,263,842	Apr. 28, 1981
Sugawara et al. (Sugawara)	4,607,565	Aug. 26, 1986
Sarbach	5,505,251	Apr. 09, 1996
Inoue	5,775,407	Jul. 07, 1998
Egawa (Egawa) (Japanese Kokai Patent)	58-122213	Jul. 20, 1983
Kampf et al. (Kampf) (German Patent Application)	DE 3514359	Oct. 23, 1986
Hagiwara et al. (Hagiwara) Japanese Kokai Patent	58-136813	Sep. 14, 1987
Geiger (German Patent Application)	DE 3940361	Jun. 13, 1991

Claims 1, 4-7, 9, 11, 13 and 14 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on an original disclosure that lacks descriptive support for the invention as now claimed.

In addition, the examiner has made the following rejections under 35 U.S.C. § 103(a):

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<sup>1</sup>With respect to the foreign language references, our understanding thereof is derived in part from translations either submitted by appellants or provided by the PTO. Copies of these translations are attached to this decision.

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(a) claims 1 and 7, on the basis of Japanese patent document 58-136813 to Hagiwara et al. (Hagiwara) in view of Inoue or Japanese patent document 58-122213 to Egawa (Egawa);

(b) claims 1 and 7, on the basis of Hagiwara in view of Inoue or Egawa, and further in view of German patent document DE 3514359 to Kampf et al. (Kampf) or German patent document DE 3940361 to Geiger (Geiger);

(c) claims 1 and 7, on the basis of Kampf and Hagiwara;

(d) claims 4-6 and 12-14, on the basis of "the prior art as applied to claim[] 1 above" (answer, page 10), and further in view of Otsuka and Logsdon;

(e) claim 5, on the basis of "the prior art as applied in claim 1 above" (answer, page 10), and further in view of Sugawara or Moore; and

(f) claims 7, 9 and 11, on the basis of "the prior art as applied to claim 1 above" (answer, page 11), and further in view of Sarbach.

Reference is made to appellants' corrected main brief and reply brief (Paper Nos. 31 and 34) and to the examiner's final rejection and answer (Paper Nos. 23 and 32) for the respective positions of appellants and the examiner regarding the merits of these rejections.

Discussion

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the examiner<sup>2</sup> and appellants, inclusive of the declaration of Hans Kampf submitted by appellants in support of their position. As a consequence of our review, we have made the determinations which follow.

The 35 U.S.C. § 112, first paragraph, rejection

The test for determining compliance with the written description requirement found in the first paragraph of 35 U.S.C. § 112 is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The content of the drawings may also be considered in determining compliance with the

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<sup>2</sup>We are aware that the examiner requested to attend the oral hearing to make a short presentation (see Paper No. 34). Regrettably, efforts by the support staff of the Board to contact the examiner and notify him of the date and time of the oral hearing were unsuccessful.

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written description requirement. *Id.* Where the specification does not contain an express written description of the claimed invention, the examiner, in making a rejection under the "written description" requirement of § 112, first paragraph, must meet the requisite burden of proof by providing reasons why one of ordinary skill in the art would not consider the description sufficient. Once the examiner has met this burden, the burden of coming forward with evidence or argument shifts to applicants to show that the invention as claimed is adequately described to one skilled in the art. *In re Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583-84 (Fed. Cir. 1996). In so doing, claim limitations which are urged to be inherent in the disclosure must be shown as having clear support from the necessary and only reasonable construction to be given the disclosure by one skilled in the art. *Kennecott Corp. v. Kyocera Int'l, Inc.*, 835 F.2d 1419, 1423, 5 USPQ2d.

Here, the later claimed subject matter questioned by the examiner is found in claims 1 and 13 and sets forth that "both the quantity and the temperature of air fed to each of the four associated heating/air-conditioning zones is independently controllable with respect to each other zone."<sup>3</sup> There appears to

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<sup>3</sup>This limitation was added by amendment to original claim 1.  
(continued...)

be no dispute that there is no express support in the original disclosure for independently controlling the quantity of air fed to each zone.

In this case we consider the reasons given by the examiner to be sufficient to make out a *prima facie* case of non-compliance with the "written description" requirement of the first paragraph of 35 U.S.C. § 112. In this regard, the examiner reasonably argues on pages 9 and 10 of answer that simultaneously and independently controlling both the temperature of the air and the volume of the air delivered to each zone is not simply a matter of opening or closing a particular set of hot or cold air flaps. The examiner logically asserts that in order to achieve control of the quantity (i.e., volume) of air to each zone independent of each other zone, while at the same time maintaining independent control of the temperature of the air to each zone, a special control would be required because a reduction in volume flow to one particular zone would have the effect of increasing the volume flow to the remaining zones unless the positions of the hot and cold air flaps

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<sup>3</sup>(...continued)  
Claim 13 is a new claim added during prosecution. All of the other claims rejected under 35 U.S.C. § 112, first paragraph, depend either directly or indirectly from one or the other of these claims.

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of each of the remaining zones were adjusted to compensate for the increased air flow volume. In light of these arguments, we consider the examiner's position to be well taken.

Appellants urge in the corrected main brief and reply brief that the disclosure in the specification that the individual hot and cold air flaps for each zone can be positioned to close off the flow of air through their respective flow paths constitutes the ability to control the volume of air flow to the respective zones, and that this ability of the disclosed structure is sufficient to place the ordinarily skilled artisan in possession of the later claimed subject matter. We do not agree. Simply put, absent some disclosure that appellants sought to independently control both the quantity and the temperature of the air flow to each zone, we do not consider the disclosure of structure that may be manipulated in a number of ways to achieve a number of different modes of operation to be sufficient to reasonably convey to a skilled artisan that appellants were in possession of the particular mode of operation now claimed.

The declaration of Hans Kampf has also been considered as it relates to this matter. In paragraph 3 of the declaration, Mr. Kampf cites various portions of the specification in support of the proposition that the hot and cold air flaps of the disclosed device

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are capable of closing off the flow of air through their respective flow paths. Based on this disclosure, Mr. Kampf concludes, without further explanation, that a person of ordinary skill in the art would understand that the volume of air fed into each of the four zones can be controlled independently of the volume of air supplied to each of the other zones. Why this is so is not apparent to us. In short, we find Mr. Kampf's declaration to be no more convincing than appellants' arguments in the corrected main brief and reply brief.

Upon careful consideration of the entire record before us, we conclude that the examiner has made out a *prima facie* case of non-compliance with the "written description" requirement of the first paragraph of 35 U.S.C. § 112 that has not been overcome by appellants' arguments and evidence. Accordingly, we will sustain the standing rejection of claims 1, 4-7, 9, 11, 13 and 14 under 35 U.S.C. § 112, first paragraph, as being based on an original disclosure that lacks descriptive support for the invention as now claimed.

The obviousness rejections<sup>4</sup>

Looking at the rejection of claims 1 and 7 on the basis of Hagiwara in view of Inoue or Egawa (rejection (a)), each of the applied references is directed to two zone heating or air-conditioning systems for a motor vehicle. More particularly, Hagiwara relates to an air-conditioning system with a configuration in which there are at least two independent zones of air conditioning such as the front seats and the rear seats (translation, page 2), while Inoue (column 3, lines 51-57) and Egawa (translation, pages 2-3) relate to air conditioning systems for controlling the temperature of a first zone at the driver's seat side and a second zone at the passenger's seat side.

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<sup>4</sup>We note in passing the examiner's view, as expressed on page 16 of the answer, that "the Examiner is under no obligation to search for and reject limitations in the claims that appellant is not entitled to claim because his specification does not provide descriptive support under 35 U.S.C. § 112, first paragraph." The examiner is misinformed. There are a number of cases that stand for the principle that it is error to ignore specific claim limitations distinguishing over the references. See, for example, *In re Glass*, 472 F.2d 1388, 1392, 176 USPQ 489, 491 (CCPA 1973). In addition, we direct the examiner's attention to the Board decision in *Ex parte Pearson*, 230 USPQ 711, 712 (1985), *aff'd mem.*, 795 F.2d 1017 (Fed. Cir. 1986) ("Even though the above quoted expressions are held by us to introduce new matter into the claims, nevertheless, they cannot be ignored, but rather, must be considered and given weight when evaluating the claims so limited with regard to obviousness over art.").

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In rejecting claims 1 and 7, the examiner notes that Hagiwara's system includes a partition 13 for dividing air flow between front seat and rear seat zones, and that Inoue and Egawa teach at elements 17 and 8, respectively, partition walls for dividing air flow between driver's side and passenger's side zones. The examiner's rationale is found on page 7 of the final rejection, where the examiner states:

To have split the casing of JA '813 [i.e., Hagiwara], in either of Figures 2 or 3, in half vertically, by installing a vertical partition in the manner taught by Inoue (at 17) or Egawa (at 8) to permit the driver and passenger sides of the vehicle (both in the front and rear as disclosed by JA '813) to have independent control over the resulting four zone system would have been obvious to one of ordinary skill in the art to improve occupant comfort. . . .

In its pithiest statement, it would have been obvious to have duplicated the (front-seat & rear-seat configuration) system shown in Figures 2 or 3 of JA '813 on either side of a vertical partition as taught by either Inoue or Egawa . . . .

While we recognize that the air-conditioning systems of Inoue and Egawa include partition walls for dividing air flow between front seat and rear seat zones, we are unable to agree with the examiner that such teaching would have suggested the incorporation of an additional partition in Hagiwara in order to provide a four zone air-conditioning system that provides for both driver and passenger side temperature control and front and rear zones

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temperature control. When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988) (citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985)). Here, each of the applied references provides for only two zone of temperature control. From our perspective, the only suggestion to meld the two zone control system of Hagiwara with the two zone control system of either of Inoue or Egawa to arrive at the claimed four zone system is found in the luxury of hindsight accorded one who first viewed appellants' disclosure. This, of course, is not a proper basis for a rejection. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fe. Cir. 1992).

For this reason, we will not sustain the rejection of claims 1 and 7 as being unpatentable over Hagiwara in view of Inoue or Egawa.

Turning to the rejection of claims 1 and 7 as being unpatentable over Hagiwara in view of Inoue or Egawa and further in view of Kampf or Geiger (rejection (b)), the examiner's additional reliance on the teachings of Kampf or Geiger relating to four zone

air-conditioning systems does not cause us to reconsider our determination *supra* that the basic combination of Hagiwara with either Inoue or Egawa is improper. First of all, in that in Geiger the chamber for mixing hot and cold air is shared by both rear seat passengers, it is not clear to us that Geiger discloses four zone temperature control. In any event, in Geiger the mixing of hot and cold air for the rear seat passengers takes place at a location far removed from where the mixing of hot and cold air takes place for the front seat passengers. This arrangement substantially differs from what is being claimed and does not provide a reasonable teaching for combining Hagiwara with either Inoue or Egawa to arrive at the claimed subject matter, which calls for all four air mixing chambers to be formed by partition walls within the air-conditioning system housing. As to Kampf, while this reference does indeed disclose in Figures 4-6 the concept of providing horizontal and vertical partition walls 15 and 16 for dividing air flow into four zones, Kampf differs substantially from Hagiwara in a number of ways, such as the heater 3, 4 being divided into two parts and the cold air bypass duct 10 being common to all zones. It is not at all clear to us how one of ordinary skill in the art would reconcile these conflicting teachings in order to reconstruct the two zone system of Hagiwara to arrive at the presently claimed

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four zone system. Here again, the examiner's conclusion of obviousness rests on an impermissible hindsight reconstruction of the claimed invention.

Accordingly, we also will not sustain the rejection of claims 1 and 7 as being unpatentable over Hagiwara in view of Inoue and Egawa and further in view of Kampf or Geiger.

We next consider the rejection of claims 1 and 7 as being unpatentable over the combination of Kampf and Hagiwara (rejection (c)). The examiner's rationale for this rejection is found on page 8 of the final rejection, where the examiner states:

Figures 4-6 of DT '359 [i.e., Kampf] discloses a four zone system downstream of a split heater 3 and 4. Cold air bypass flaps 7, 8, 7' and 8' close off four cold air bypasses. Air mix dampers 5 and 6 in both figures 5 and 6 control cold/hot air mix ratios. To have modified DT '359 with either of the heater/bypass configurations taught by JA '813 [i.e., Hagiwara] to permit the use of a single heater core rather than the split type shown by DT '359 would have been obvious to one of ordinary skill in the art. . . .

First, the examiner has not stated why one of ordinary skill in the art would have been motivated to modify Kampf in the manner proposed in view of the teachings of Hagiwara. For this reason alone, the rejection is not sustainable. Second, Kampf states on pages 6-7 of the translation that the subdivided heater unit 3, 4 is instrumental in achieving Kampf's objective of low airside

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resistance so that the device can achieve increased air throughput. Since the examiner's proposed modification of Kampf would involve eliminating Kampf subdivided heater unit, the above noted disclosure of Kampf would act as a discentive for the proposed modification. Third, the examiner's cut and paste rendition on page 9 of the final rejection of how Kampf's device would look as a result of the proposed modification appears to us to be a hindsight reconstruction of the claimed device arrived at by impermissibly utilizing appellants' own disclosure and claims as a target to be hit by invention-guided manipulation of the applied reference teachings. As noted by our court of review in *In re Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1783, it is impermissible to use the claimed invention as an instruction manual or "template" in attempting to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious. Such is the case here with respect to the examiner's proposed modification of Kampf in view of Hagiwara.

In light of the foregoing, the rejection of claims 1 and 7 as being unpatentable over the proposed combination of Kampf and Hagiwara will not be sustained.

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Concerning the remainder of the examiner's obviousness rejections, we have carefully reviewed the Otsuka and Logsdon references additionally applied in rejection (d), the Sugawara or Moore references additionally applied in rejection (e), and the Sarbach reference additionally applied in rejection (f), but find nothing therein to make up for the deficiencies of the underlying reference combinations applied in rejections (a), (b) and (c). Accordingly, we also will not sustain any of these remaining rejections.

Summary

The standing rejection of 1, 4-7, 9, 11, 13 and 14 under 35 U.S.C. § 112, first paragraph, is affirmed.

All other rejections are reversed. → 35 USC 103

The decision of the examiner finally rejecting claims 1, 4-7, 9 and 11-14, is affirmed-in-part.

(12) is allowed

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

LJS/lp

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